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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,086	03/16/2004	Garrett Blythe	353980-991100	4038

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EXAMINER

D'AGOSTINO, PAUL ANTHONY

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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11/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/802,086	Applicant(s) BLYTHE ET AL.	
	Examiner Paul A. D'Agostino	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 08/06/2008. Claims 1, 12 and 18 have been amended. Claims 25 and 26 have been cancelled. Claims 1-24 are now pending in this application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/2008 has been entered.

Response to Amendment

2. The previous Office Action filed 2/6/2008 incorporated the prior Office Action filed 7/20/2008 and in so doing left gaps in the prosecution history caused by both sides.

This Office Action reaches back to the Office Action filed 7/20/2008 and brings everything up to date.

3. This acknowledges and accepts the corrected drawings filed 8/6/2008, specification changes filed 11/20/2007, and claim amendments in response to the claim objections filed 11/20/2007. Thus, the objections to the drawings, specifications, and claims are withdrawn.

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4. There is no record of an Examiner response to Applicant's Arguments/Remarks filed 11/20/2008 with respect to the rejection of claims 1-24 under 35 USC §102(e) in view of U.S. Patent Pub. No. 2004/0224769 to Hansen. In the absence of a response and the fact that Hansen is duplicative under the current claims the rejection of Claims 1-24 with respect to Hansen is withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 7-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Pub. No. 2002/0086732 to Kirmse (Kirmse) of record.

Kirmse discloses a client-server system including a plurality of game clients, a game server, a plurality of messenger clients, and a messenger server. The game server includes logic to operate a multiplayer game using inputs from and outputs to an active game set of game clients, wherein game clients other than those in the active game set can join an active game by supplying the game server with a reference to the active game. The messenger server includes logic to forward messages from a sender messenger client to a receiving messenger client (para. 0008). Additionally, logic is included for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message

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sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee. Kirmse additionally discloses:

Re claims 1, 12, and 18. Kirmse discloses a system (10) for facilitating multiplayer gaming over a computer network (16), the system comprising: a client program running on a terminal (12) that automatically detects when selected individuals are playing certain multiplayer games on the computer network (Figs. 1 and 8-10; paras. 0029 and 0053), notifies a user of the games and the selected individuals playing the games (para. 0053) and wherein the program detects one or more of the games are running on the terminal (Figs. 9-10 and paras. 0053-0057 e.g., as tom123494949 enters a game to play, the "available" smiley indicator next to tom123494949's user identifier of Fig. 8 switches to an activity name in which tom123494949 is interacting with as shown in Fig. 9." (para. 0053).

Re claims 2, 12 (more of), and 19. The system of claim 1, wherein the client program is further adapted to allow the user to join an individual in a game by running an instance of the game on the terminal and connecting the terminal to a location hosting the game (para. 0010; 0054; 0056-57). Moreover, the claim language "adapted to" is an intended use limitation that does not distinguish the claimed system over the prior art. The claim recitation is not a positive limitation, thus, the client program only requires the ability to perform. Furthermore, while features of an apparatus may be

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recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. (MPEP § 2114).

Re claim 3. The system of claim 2 wherein the client program further generates a user interface that allows the user to join an individual in a game by selecting an icon (friend's identifier or smiley face icon) (Fig. 10; para. 0054; 0077).

Re claims 4, 13, and 20. The system of claim 2 wherein the client program is further adapted to detect running games on the user terminal and to communicate data identifying the running games and the user over the computer network for receipt by selected individuals (Fig. 8-10; para. 0053).

Re claim 5. The system of claim 4 further comprising: a second program that determines a connection status of the running games and communicates the connection status to the client program (para. 0010, lines 1-11); wherein the client program is further adapted to communicate the connection status of the running games over the computer network for receipt by the selected individuals (para. 0010, lines 11-13).

Re claims 7, 14, and 21. The system of claim 5 wherein the connection status comprises an IP address hosting a corresponding game (para. 0035; 0086).

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Re claim 8. The system of claim 5 further comprising: one or more servers (messenger server) adapted to receive the data and connection status and to communicate the data and connection status to the selected individuals (18, Fig. 1; 118, Fig. 12; para. 0010; 0053).

Re claims 9, 15, and 22. The system of claims 1 and 2 wherein the program is further adapted to allow the user to send and receive instant messages to and from selected individuals (para. 0029). Also, see the intended use rationale provided above.

Re claims 10, 16, and 23. The system of claim 9 wherein the selected individuals include individuals stored on a friend list created by the user (para. 0003). Re claims 11, 17, and 24. The system of claim 10 wherein the selected individuals include individuals stored on a friend list created by an individual stored on a friend list created by the user (para. 0003: since a user has a friend list (as shown in Figs. 8-10), then a friend on the list also has a friend list because both the user and the friend have the IM software).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0086732 to Kirmse (Kirmse) of record and in view of U.S. Patent Pub. No. 2004/0032876 to Garg (Garg) of record.

Kirmse discloses a system substantially equivalent to Applicant's claimed invention. Kirmse fails to disclose the system of claim 5 wherein the second program comprises an LSP program.

In an analogous reference, Garg teaches of a network system that uses an LSP

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to intercept data sent and received by a client device. Garg is silent to a gaming network. However, Garg teaches of an LSP program (para. 0021).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Garg's LSP program in Kirmse. One would be motivated to do so in order to take advantage of current technology to monitor which game server the user is connecting to so that an IP address can be obtained for other players to connect to the same server to play the same game.

Response to Arguments

11. Applicant's arguments filed 8/6/2008 have been fully considered but they are not persuasive. Applicant argues that Kirmse fails to disclose "wherein the client program is further adapted to search for and detect when one or more of the games are running on the terminal." (see Applicant's Arguments/Remarks page 6). Examiner respectfully disagrees. Examiner directs Applicant to paras 0053-0057 and specifically para 0053 wherein "the program detects one or more of the games are running on the terminal (Figs. 9-10 and paras. 0053-0057 e.g., as tom123494949 enters a game to play, the "available" smiley indicator next to tom123494949's user identifier of Fig. 8 switches to an activity name in which tom123494949 is interacting with as shown in Fig. 9". This explicitly indicates when and what games are running on the terminal. Thus the rejection of claims 1-24 are maintained.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714